

REMARKS

Applicant has reviewed and considered the office action mailed on September 13, 2002 and the references cited therewith.

Claims 1, 3-4, 9-13, and 19-21 are amended, claims 6-8 and 14-16 are cancelled, and claims 23-33 are added; as a result, claims 1-5, 9-13, and 17-33 are now pending in the application. Claims 3-4, 10-13, and 19-21 were not amended in response to an art rejection. They were amended in response to objections, indefiniteness rejections, and to more fully clarify the subject matter included in the claims. Support for the amendments to claims 1 and 9 is found, for example, at page 2, line 30 and page 3, lines 1-2.

Claim Objections

Claims 3, 10 and 21 were objected to for informalities. Claims 3, 10, and 21 have been amended. Applicant respectfully submits that the amended claims overcome the objections. Therefore, applicant requests withdrawal of the objections and reconsideration and allowance of claims 3, 10, and 21.

§112 Rejection of the Claims

Claims 4 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 4 and 20 as suggested in the office action. Applicant respectfully submits that claims 4 and 20, as amended, are not indefinite. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 4 and 20.

Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 12 as suggested in the office action. Applicant respectfully submits that claim 12, as amended, is not indefinite. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 12.

§102 Rejection of the Claims

Claims 1-5, 9-13, and 17-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kresch et al. (U.S. Patent No. 5,527,331). Applicant respectfully traverses the rejections of claims 17-21.

Claim 1, as amended, recites, "biocompatible means positioned in the introducer member for cutting tissue entering the opening as the means for cutting travels with respect to the opening *without rotating*." (emphasis added) Claim 9, as amended, recites, "using a cutting member positioned in the introducer, cutting tissue entering the opening by moving the cutting member with respect to the opening *without rotating the cutting member*." (emphasis added) In contrast, Kresch et al., at Fig. 2A and at column 7, lines 33-36, teach a rotating cutting head C. Similarly, Figs. 6A, 6B, and 6C teach "rotating" cutting heads as indicated by the rotation symbol (curved arrow). Although Fig. 9 illustrates an electrosurgical member 202 that is not intended to rotate, Fig. 9 fails to teach "a biocompatible cylindrical introducer member with an outer wall and a hollow core, the cylindrical member having a longitudinal axis and *an opening along a side*," as recited in claim 1. As can be seen in Fig. 9, the sheath 226 fails to have "an opening" and therefore fails to teach an opening. Hence, Kresch et al. do not teach each of the elements of claim 1 or claim 9. Thus, the office action fails to state a *prima facie* case of anticipation with respect to claim 1 or claim 9.

Claims 2-5 are dependent on claim 1. Claims 10-13 are dependent on claim 9. For reasons analogous to those provided above and the elements in the claims, applicant respectfully submits that the office action fails to state a *prima facie* case of anticipation with respect to claims 2-5 and claims 10-13. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 1-5 and 9-13.

Claim 17 recites, "a biocompatible cylindrical inner member . . . an opening along a side and sized to fit inside the introducer member" and "means for cutting *tissue entering the opening in the inner member* as the means for cutting travels with respect to the opening in the inner member." (emphasis added) In contrast, Kresch et al. teach, for example, as shown in Fig. 2A, a probe P, at column 7, line 24, and a cutter C, rotating in the direction of arrow 22, but fails to teach "a biocompatible cylindrical inner member . . . sized to fit inside the introducer member"

and "means for cutting *tissue entering the opening in the inner member* as the means for cutting travels with respect to the opening in the inner member." (emphasis added) In fact, applicant is unable to find any reference in Kresch et al. to "a biocompatible cylindrical inner member" including "tissue entering the opening in the inner member." Hence, Kresch et al. fail to teach each of the elements of claim 17. Hence Kresch et al. fail to state a *prima facie* case of anticipation with respect to claim 17.

Claims 18-21 are dependent on claim 17. For reasons analogous to those provided above and the elements in the claims, applicant respectfully submits that the office action fails to state a *prima facie* case of anticipation with respect to claims 18-21. Therefore, applicant requests withdrawal of the rejections and reconsideration and allowance of claims 17-21.

§103 Rejection of the Claims

Claims 6-8, 14-16 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kresch in view of Parisi (U.S. Patent No. 5,674,235). Claims 6-8 and 14-16 are cancelled by this amendment, so the rejections are moot. Applicant traverses the rejection of claim 22.

The office action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The office action states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the ultrasonic energy source of Kresch to engage the cutting edge, as taught by Parisi, in order to obtain a more precise incision and cauterize the incision simultaneously." Since the office action only provides the above quoted conclusory statement regarding the motivation to combine the references, applicant respectfully submits that the references are not combinable and thus the office action fails to state a *prima facie* case of obviousness with respect to claim 22. Therefore, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 22.

So called "prior art" "made of record but not relied upon"

Several patents were cited as "pertinent to applicant's disclosure" but not relied upon to reject claims. In view of the fact that the patents were not asserted against any claims, applicant need not respond either to the assertion of their pertinence or to any assertion that any of the listed patents constitutes "prior art" to any pending claim. Applicant expressly reserves the right to challenge any such assertion, should it be included in some future rejection.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone applicant's attorney at 612-371-2109 to facilitate prosecution of the application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date March 13, 2003

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 13th day of March, 2003.

PATRICIA A. HULTMAN

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Signature